

### REMARKS

Receipt of the Office action mailed March 24, 2003 is acknowledged. In the Office action claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 7, and 13 were rejected as being anticipated by Griswold et al. (U.S. Patent No. 6,027,115) and claims 2-6, 8-12, and 14-18 were rejected under a number of references. In the above amendments, claims 1-12 have been cancelled and claims 19- 26 have been added.

This response is timely filed, as it is accompanied by a petition for a one month extension of time, and the requisite petition fee.

In view of above amendments and the following remarks, reconsideration of the application is respectfully requested.

#### Indefiniteness rejections

Claims 1-18 were rejected under §112, second paragraph, as being indefinite for use of the term "about" in claims 1, 7, and 13. The Office action states that "[t]he term 'about' is not defined by the claim" since "in relation to a measurement of degree [the term 'about'] does not define what exact degree is encompassed by the claim and is therefore indefinite."

It is respectfully submitted that, according to both the MPEP and case law, the use of the term "about" in a claim does not render the claim indefinite. For example, as stated in MPEP § 2173.05(b):

The term "about" used to define the area of the lower end of a mold as between 25 to about 45% of the mold entrance was held to be clear, but flexible. Ex parte Eastwood, 163 USPQ 316 Bd. App. 1968). Similarly, in W.L.Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the court held that a limitation defining the stretch rate of a plastic as "exceeding about 10% per second" is definite because infringement could clearly be assessed through the use of a stopwatch.

(emphasis added).

Furthermore, according to Patent Office procedures, claim language should be granted some latitude in manner of expression. Specifically, as set forth in MPEP § 2173.02:

[The examiner] should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner

might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

(emphasis added)

Moreover, the courts have noted that the expression “about” may be used when flexibility is desired in the claim language. For example, in *Ex parte Eastwood*, the court stated that “[t]he descriptive word ‘about’ is not indefinite as argued by the examiner. Its meaning is not as broad and arbitrary as contended by the examiner. Rather, the term is clear but flexible and is deemed to be similar in meaning to terms such as ‘approximately’ or ‘nearly’.” (163 USPQ 316, 317). Similarly in, *Syntex, Inc., v. Paragon Optical, Inc.*, 7 USPQ2d 1001, 1038 (D. Ariz 1987) the court noted that “[t]he descriptive term ‘about’, which is used to explain the claimed ranges in the patents in suit, does not render a claim indefinite. Under 35 U.S.C. § 112 the term ‘about’ entitles the patentee to a broad interpretation of any range claimed in the patent.” Finally, in *Kolene Corp. v. Motor City Metal Treating, Inc.*, 307 F. Supp. 1251, 1258 (E.D. Mich. 1969), *aff’d* 440 F. 2d 77 (6<sup>th</sup> Cir. 1971), *cert denied*, 404 U.S. 886 (1971), the court held that “[a]s a matter of law, the term ‘about’ is a clear warning that exactitude is not claimed but rather a contemplated variation.”

Since, both the MPEP and the courts have held that the use of the term “about” in a claim does not render the claim indefinite, it is respectfully submitted that the claims in this case are not indefinite.

### **The Rejection of Claim 13**

Independent claim 13 stands rejected under 35. U.S.C. § 102(b) as being anticipated by Griswold et al. (U.S. Patent No. 6,027,115).

Independent claim 13 recites, *inter alia*, a gaming apparatus having a slot machine reel rotatable about an axis and having an outer circumferential region with a flexible display mounted on the outer circumferential region of the gaming apparatus reel. The flexible display having a flexibility that allows the flexible display to be elastically bent from a substantially straight configuration to a curved configuration, wherein the curved configuration is capable of contacting the outer circumferential region of the gaming apparatus reel at two points separated by an angular displacement of about ninety degrees,

and wherein the flexible display is adapted to display an indicium to a player of the gaming apparatus.

Thus, the plain language of claim 13 defines a display that is capable of generating an indicium and that is elastically flexible through an arc of about ninety degrees. It should be noted that the plain and ordinary meaning of “elastic” is the ability of something to readily return to its original shape after being flexed. For example, *The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company*, sets forth a definition of elastic as “Easily resuming original shape after being stretched or expanded.” A copy of that definition is enclosed.

Referring to the gaming apparatus of Griswold, the Office action states:

The gaming apparatus also includes a flexible display in the form of a reel strip (Column 3, lines 39-42) that allows the reel strip to be bent from a substantially straight configuration to a curved configuration. This curved configuration is capable of contacting the outer circumferential region of the reel at two points (FIG 3A). While the exact angular displacement is not disclosed, it is inherent that for the strip to function in a gaming reel of a round configuration as disclosed, the displacement would be ninety degrees between the points.

The standard for inherency is strict. Section 2112 of the M.P.E.P. sets forth the standard for inherency as follows:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

(emphasis added).

The excerpt from the Office Action cites column 3, lines 39-42 of Griswold as disclosing a flexible reel strip. That entire paragraph of the Griswold patent that contains that excerpt is set forth below:

Yet another aspect of the invention provides a reel strip for use as a display portion of a slot machine reel. Such reel strips may be characterized as including the following elements: (a) a flexible substrate; (b) a first electrode formed on the substrate; (c) one or more electroluminescent elements formed on at least a portion of the first electrode; and (d) a second electrode formed over at least the electroluminescent elements. At least one of the first and second electrodes should be transparent. Often a second substrate, including inked images of symbols, will be affixed to the second electrode. (Column 3, lines 39-49)

As disclosed in the above excerpt and in other sections of the patent, Griswold discloses a reel strip 303 that is constructed from at least five separate layers: 1) a substrate 450 which may be made from a flexible material, 2) a conductive layer comprising traces 405 and lower capacitor plates 407, 3) an isolation layer 455 containing electroluminescent dielectric elements 453, 4) another conductive layer comprising traces 421 and capacitor plates 423, and 5) a printed cover strip 457 containing silk screened (i.e., static) images.

Although the excerpt at column 3, lines 39-42 of Griswold cited in the Office Action discloses that the reel strip may include a flexible substrate, that does not mean that the reel strip is itself flexible as stated in the Office Action (i.e., Griswold “includes a flexible display in the form of a reel strip”). That is because the flexible substrate 450 is only one of at least five layers of the reel strip. There is no express disclosure in Griswold that the reel strip, after all of its constituent layers have been assembled together, is flexible, nor is there any express disclosure that the reel strip, after assembly, is elastically flexible through an arc of about ninety degrees as recited in claim 13.

It is respectfully submitted that there is also no inherent disclosure in Griswold that the reel strip 303 is elastically flexible through an arc of about ninety degrees as recited in claim 13. As but one general example, it should be apparent that if two layers that were separately elastically flexible through an arc of about ninety degrees were bonded together with an adhesive to form a composite structure, that composite structure would not necessarily be elastically flexible through an arc of about ninety degrees.

As but one example, the adhesive could fail as the composite structure is flexed, thus destroying the composite structure. This scenario could apply: 1) if the adhesive were

applied to the substrates when they were in a straight configuration and if the resulting composite structure were then attempted to be bent through an arc of about ninety degrees after the adhesive dried, or 2) if the adhesive were applied to the substrates when they were in a curved configuration about an arc of ninety degrees and if the resulting composite structure were then attempted to be straightened.

It is respectfully submitted that, whether or not the reel strip disclosed in Griswold is elastically flexible through an arc of about ninety degrees is mere conjecture, which clearly does not satisfy the stand for inherent disclosure.

For the reasons set forth above, it is respectfully submitted that claim 13 is not anticipated by Griswold.

### **The Rejection of Claims 14-18**

Claims 14, 17 and 18 stand rejected under 35. U.S.C. §103(a) as being unpatentable over Griswold in view of Acres et al. (U.S. Patent No 6,008,784) in view of "Universal Display: FOLED Technology" ("FOLED"). Claims 15 and 16 stand rejected under 35. U.S.C. §103(a) as being unpatentable over Griswold in view of Acres et al. (U.S. Patent No 6,008,784) in view of FOLED for the same reasons as claims 14, 17 and 18, and further in view of "Business Week 2000: The Tube."

The mere fact that references can be modified is not sufficient to establish a prima facie case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (emphasis original).

In order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), where the Court of Appeals for the Federal Circuit stated:

The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**. Broad conclusory statements regarding the teaching of multiple references, standing alone, are **not 'evidence.'** (emphasis added, citations omitted).

The suggestion to combine references must be from the prior art, not Applicants' disclosure. See Section 2143 of the M.P.E.P., which states: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

The rejections of all of claims 14-18 are based on the following excerpt from the Office Action:

Universal Display Corporation: FOLED Technology discloses that it is advantageous to substitute the use of normal LEDs with the FOLED technology.

Motivations for doing so include the flexibility of FOLED, the ultra-lightweight, thin-form, as well as the durability and cost-effective processing. Therefore it would have been obvious to one of ordinary skill in the art to incorporate the dynamic FOLED format into the flexible display as disclosed by Acres et al. in order to provide a more efficient, flexible, durable and cost effective means to display information. One would be motivated to incorporate FOLED as cost would be reduced as FOLED is less breakable, more impact resistance and more durable as well as more cost-effective to produce.

Office Action, p. 5 (emphasis added).

Thus, the motivations set forth in the Office Action for combining the applied documents cited can be summarized as the following: 1) flexibility; 2) weight reduction; 3) durability; and 4) cost-effectiveness.

#### Flexibility

The combination proposed in the Office Action is predicated on both Griswold and Acres as disclosing flexible displays. Given that view set forth in the Office Action that both Griswold and Acres already disclose flexible displays, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine FOLED with Griswold and Acres for reasons of flexibility.

#### Weight Reduction

Acres and Griswold disclose casino-type slot machines, which are typically large, stationary machines utilized in casinos. While FOLED states that the use of a flexible display will "reduce the weight of flat panel displays in cell phones, portable computers, and,

especially, large-area televisions-on-the-wall,” there is no suggestion that they be used in gaming machines. Moreover, it is respectfully submitted that one of ordinary skill in the art would know that the weight of casino-type slot machines is not important and that the trivial “weight reduction” that could conceivably be yielded by FOLED, while important to cell phones and laptops as disclosed in FOLED, would be irrelevant to casino-type slot machines. Therefore, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine FOLED with Griswold and Acres for purposes of weight reduction.

#### Durability

FOLED states that the disclosed display “will also generally be less breakable, more impact resistant and more durable compared to their glass counterparts.” Griswold and Acres, however, are directed towards casino-type slot machines, which typically have the reels disposed behind a glass plate or some other type of protective cover to secure the operations of the machine from the user (e.g., to prevent cheating, or vandalism). Durability may be important, as disclosed in FOLED, in the context of a portable computer, which typically has a display that the user can physically touch. However, it is respectfully submitted that durability of slot machine reels such as disclosed in Griswold and Acres is irrelevant since slot machine reels are typically disposed behind a protective cover and cannot be physically touched and are therefore not subject to wear. Therefore, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine FOLED with Griswold and Acres for purposes relating to durability.

#### Cost-Effectiveness

FOLED, which refers to the use of flexible displays for “cell phones, portable computers and, especially large-area televisions-on-the-wall,” states that such flexible displays “are projected to have full-production level cost advantages over most flat panel displays.” (emphasis added). It is respectfully submitted that such potential products are commodity type products directed toward the consumer market for which cost is particularly important, unlike casino-type slot machines. Consequently, it is respectfully submitted that “projected cost advantages” for products other than casino-type slot machines does not provide a sufficient suggestion to combine FOLED with Griswold and Acres.

For the foregoing reasons, it is respectfully submitted that claims 14-18 would not have been obvious in view of the applied documents.

In support of the rejection of claims 15 and 16, the Office Action indicates that low power consumption was a purported motivation for the combination of Griswold, Acres, FOLED, and the Tube:

A possible motivation to one of ordinary skill in the art to use a flexible LCD over a FOLED is that LCD is known to consume very little power and thus would save the casino money in the electricity required to run the machine. Hence the use of a flexible LCD over a FOLED would have been obvious to one of ordinary skill in the art.

Office Action, p. 6.

While the Tube discloses a "low voltage LCD which lets a pared-down processor do most tasks," the Tube is concerned with a laptop computer, wherein battery life and power consumption is of utmost concern. It is respectfully submitted that that concern is clearly not applicable to casino-type slot machines such as disclosed in Acres and Griswold. Therefore, it is respectfully submitted that claims 15 and 16 would not have been obvious in view of the applied documents for that reason as well.

#### New Claims 19-26

It is respectfully submitted that the new independent claims, as well as the dependent claims, are in condition for allowance for at least the reasons noted above.

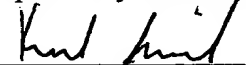
#### Conclusion

In view of the foregoing, the above-identified application is believed to be in condition for allowance. In the event there is any remaining issue that the examiner believes can be resolved by a telephone conference, the examiner is respectfully invited to contact the undersigned attorney at the number identified below.

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By:

Respectfully submitted,



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